

Serial No. 08/787,651

Remarks

Claims 1-36 and 38-39 are pending in the application.

Claims 36 and 38 stand allowed.

Claims 1-21, 26, 28, 30, 31, and 33 are rejected under 35 U.S.C. 101, the Office Action stating that those claims are drawn to non-statutory subject matter.

Claims 1-39 are provisionally rejected under the Judicially created doctrine of double patenting as being unpatentable over claims 1-58 of copending United States Patent No. Application Serial No. 10/673,892.

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered. In this regard, please see the argument regarding the rejection under 35 U.S.C. 101.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly

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include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

**Rejection Under 35 U.S.C. 101**

Claims 1-21, 26, 28, 30, 31, and 33 are rejected under 35 U.S.C. 101, the Office Action stating that those claims are drawn to non-statutory subject matter. This ground of rejection is predicated on the recent Federal Circuit case *In re Bilski*. Between the issuance of the rejection and the present time *In re Bilski* has been accepted for Certiorari by the United States Supreme Court. As a result, the law in this area may change, or appear to change, yet again. Therefore, since applicant does not agree with *In re Bilski* and the way it is being interpreted, while recognizing that until the United States Supreme Court speaks on this issue it remains the law, applicant has amended the claims herein in what is hoped to be a most narrow manner to permit the claims to comply with the *In re Bilski* requirements and no other reason. Furthermore, in the event that the United States Supreme Court changes the current interpretation of the law, applicant reserves the right to revert to claims that are broader than the amended claims, even back to the language of the original claims, without it being considered any form of recapture. Furthermore, it is noted that doing so would not require any additional search or examination, since claims of such scope have already been searched and deemed allowable but for this issue.

Independent claims 1, 30, and 39 have all been amended to indicate that steps recited therein are performed automatically by an apparatus adapted to watermark a video signal, i.e., a particular machine. Applicant notes that by the amendment, such steps of the claims are performed by the recited apparatus. Also, claim 20 has been amended to require its combining step be performed in the recited receiver, i.e., a particular machine. Moreover, applicant's claims do not recite a law of nature, a fundamental equation, and are not mere mental steps. Thus, applicant's amended claims 1, 20, 30, and 39 are directed to patentable subject matter. So too then are their associated dependent claims.

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**Double Patenting Rejection**

Claims 1-39 are provisionally rejected under the Judicially created doctrine of double patenting as being unpatentable over claims 1-58 of copending United States Patent No. Application Serial No. 10/673,892.

Since a double patenting rejection depends on the claims of the application, until applicants have claims that are allowable but for the double patenting rejection, applicants cannot evaluate the correctness of any suggested double patenting rejection. As such, applicants also cannot determine any arguments that might be put forth against the suggested double patenting rejection. Therefore, as this double patenting rejection is premature, applicants will address such a ground of rejection once all other grounds of rejection are overcome. Furthermore, as this is merely a provisionally double patenting rejection, this rejection may resolve itself depending upon the order in which allowances are secured.

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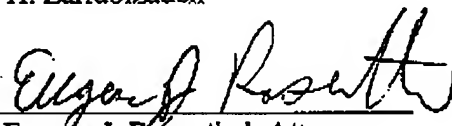
It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, he is invited to call applicant's attorney so that arrangements may be made to discuss and resolve any such issues.

In the event that an extension of time is required for this amendment to be considered timely, and a petition therefor does not otherwise accompany this amendment, any necessary extension of time is hereby petitioned for, and the Commissioner is authorized to charge the appropriate cost of such petition to the Alcatel-Lucent USA Inc. Deposit Account No. 12-2325.

Respectfully,

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By   
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Lucent Technologies Inc.

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